REMARKS

Summary of Office Action

Claim 34-56, i.e., all claims of record, are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stroud et al., U.S. Patent No. 6,231,837 (hereafter "STROUD") in view of Fowler et al., U.S. Patent No. 6,391,290 (hereafter "FOWLER").

Response to Office Action

Reconsideration and withdrawal of the rejection of record are respectfully requested, in view of the following remarks.

The instant rejection under 35 U.S.C. § 103(a) essentially alleges that the subject matter recited in instant claims 34-54 is rendered obvious by STROUD and that the remaining elements recited in claims 55 and 56 are rendered obvious by FOWLER.

Applicants respectfully traverse this rejection. In particular, it is pointed out that the generic disclosure of STROUD is extremely broad and encompasses, for example, compositions comprising, *inter alia*, from about 0.5 % to about 20.0 % by weight of a self-tanning skin coloring agent subject to chemical instability (which is preferably dihydroxyacetone) and from about 0.1 % to about 15.0 % by weight of a polyol comprising a polyhydric compound having at least three hydroxyl groups and at least three carbon atoms (which is preferably D-sorbitol). See, e.g., abstract of STROUD.

In other words, the generic disclosure of STROUD encompasses, for example, compositions which contain any self-tanning skin coloring agent subject to chemical instability and any polyol comprising a polyhydric compound having at least three hydroxyl groups and at least three carbon atoms in weight ratios of from 1 : 30 to 200 : 1.

However, a closer look at STROUD reveals that the actual teaching thereof is much narrower. In particular, while STROUD focuses on dihydroxyacetone as the self-tanning skin coloring agent subject to chemical instability, STROUD lists almost 20 suitable examples of polyols and types of polyols (including glycerin), the majority of which are sugars and sugar alcohols (see col. 7, lines 35- 42 and col. 15, lines 38-45 of STROUD). Further, the preferred polyols are D-sorbitol, D-mannitol and inositol, most preferably sorbitol (see, e.g., col. 7, lines 42-43, 53-54 and 64 of STROUD). Sorbitol is also the only polyol that is employed in the exemplified compositions of STROUD. See also the reaction schemes depicted in columns 27 and 28 of STROUD (which also show sorbitol).

Further, with respect to the concentration of dihydroxyacetone as the preferred self-tanning skin coloring agent subject to chemical instability STROUD teaches that about 4.0 % to about 6.0 % by weight should be used (see, e.g., col. 10, lines 4-8). In accordance therewith, the concentration of dihydroxyacetone in the exemplified compositions of STROUD is between 4.00 % and 6.00 % by weight.

Even further, regarding the concentration of polyol in the compositions taught therein, STROUD teaches that the polyol is preferably present in concentrations from about 0.2 % to about 10 % by weight, more preferably from about 0.3 % to about 5.0 % by weight, more preferably still

from about 0.4 % to about 3.0 % by weight and most preferably from about 0.5 % to about 1.5 % by weight (see, e.g., col. 15, lines 48-53, col. 7, lines 53-57, col. 9, lines 12-13 and the exemplified compositions of STROUD wherein sorbitol solution (presumably 70 % by weight of sorbitol as indicated in Table 3) is employed in a concentration of from 1.00 % to 5.00 % by weight (0.7 % to 3.5 % by weight of sorbitol)).

In view of the foregoing, it is not seen that STROUD prompts one of ordinary skill in the art to employ a polyol which, although mentioned once and among many other polyols in STROUD, clearly is not preferred and differs structurally significantly from the most preferred polyol of STROUD, i.e., D-sorbitol, in a concentration (i.e., more than 5 % by weight) which, although possible according to the general teaching of STROUD, is significantly higher than the most preferred concentrations and also significantly higher than the highest concentration of polyol employed in any of the exemplified compositions of STROUD (i.e., 3.5 % by weight of sorbitol, see Table 3 of STROUD)).

It also is not seen that one of ordinary skill in the art would be prompted by STROUD to employ a ratio of dihydroxyacetone and glycerin which is smaller than 1:1, despite the fact that the weight ratio of dihydroxyacetone to polyol (D-sorbitol) in all of the exemplified compositions of STROUD is significantly higher than 1:1, i.e., at least 1:0.7 (see Table 3) and as high as (at least) 6:1 (see, e.g., Table 2 of STROUD, assuming a 100 % solution).

In this regard, the Examiner is reminded that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); *In re Jones*,

958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

Applicants further submit that FOWLER is unable to cure the above-noted deficiencies of STROUD, even if one were to assume, *arguendo*, that one of ordinary skill in the art would have an apparent reason to combine the teachings of STROUD and FOWLER in the way contemplated by the Examiner. At any rate, the Examiner appears to have relied upon the disclosure of FOWLER only with respect to dependent claims 55 and 56.

In this regard, it is noted that what FOWLER has in common with the compositions of (commonly assigned) STROUD is that the compositions exemplified in FOWLER and in particular, those containing a polyol also contain not more than 3.5 % by weight of sorbitol (5.00 % by weight of a 70 % solution). Also, some of the exemplified compositions of FOWLER contain glycerol, but in a concentration which is not higher than about 3 % by weight. Accordingly, FOWLER also fails to teach or suggest employing a polyol such as sorbitol or glycerol in a concentration which is significantly higher than 3 % and 3.5 %, respectively and thus reinforces the teaching of STROUD in this respect.

Applicants submit that for at least all of the foregoing reasons, STROUD in view of FOWLER fails to render obvious the subject matter of any of the claims of record, wherefore withdrawal of the instant rejection is warranted and respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, wherefore an early issuance of the Notices of Allowance and Allowability is respectfully solicited. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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June 25, 2010
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